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OFFICE OF PETITIONS

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In re Application of :
John S. Yates, Jr., et al. :
Application No. 09/385,394 : **DECISION ON PETITION**
Filed: August 30, 1999 :
Attorney Docket No. 114596-03-4000 :

This is a decision on the petition entitled "PETITION TO THE DIRECTOR REGARDING PREMATURE FINAL REJECTION (MPEP § 706.07(c))" filed on April 17, 2006. This petition is treated as a petition under 37 CFR 1.181 requesting that the Director invoke his supervisory authority and review the Technology Center (TC) Director's decisions mailed on November 8, 2005 and February 10, 2006. Petitioners are requesting that the finality of the final Office action mailed on October 25, 2004 be withdrawn, and/or that the after-final amendment filed on April 28, 2005¹ be entered.

This is also a decision on the petition entitled "RENEWED PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136(b)" filed on April 17, 2006, requesting that the time period for filing an appeal brief be extended.

The TC Director's decisions have been reviewed. The petition under 37 CFR 1.181, requesting the withdrawal of the finality of the final Office action mailed on October 25, 2004, and the entry of the after-final amendment filed on April 28, 2005, is **DENIED**.

The petition under 37 CFR 1.136(b), requesting extensions of time for filing an appeal brief, is **GRANTED** to the extent that a one-month time period is provided for applicants to file an appeal brief in compliance with 37 CFR 41.37.

Accordingly, the finality of the final Office action mailed on October 25, 2004 is **not** withdrawn and the entry of the after-final amendment filed on April 28, 2005 is **denied**. An appeal brief in compliance with 37 CFR 41.37 must be filed within the **one month** from the mailing date of this decision to avoid *sua sponte* dismissal of the appeal. This time period is extendable under 37 CFR 1.136(a).

¹ The after-final amendment was filed on April 28, 2005, with a certificate of mailing date of April 25, 2005.

BACKGROUND

1. The instant application was filed on August 30, 1999, as a continuation-in-part of U.S. patent application 09/322,443. The application-as-filed contains 143 pages of specification, an additional 20 pages of claims (total 95 claims), and 41 sheets of drawings.
2. On February 11, 2004, a non-final Office action was mailed after the filing of a request for continued examination (RCE).
3. On July 15, 2004, a reply to the non-final Office action including amendments to the claims and cancellation of claims 61-62 and 117-118, and an information disclosure statement (IDS) were filed.
4. A final Office action was mailed on October 25, 2004.
5. On January 25, 2005, a reply was filed including: a first after-final amendment under 37 CFR 1.116, an IDS, as well as a request for reconsideration and request to withdraw the finality of the final Office action mailed on October 25, 2004.²
6. On February 14, 2005, an advisory action was mailed, indicating that the first after-final amendment would not be entered as the amendments to the claims raised new issues that would require further consideration and/or search.
7. On April 8, 2005, a petition under 37 CFR 1.181 requesting the Director to invoke his supervisory authority, withdraw the finality of the final Office action mailed on October 25, 2004, enter the first after-final amendment, and consider the IDS filed on January 25, 2005.
8. On April 14, 2005, an updated version of the submission dated April 8, 2005, a reply, exhibit, a second after-final amendment, a petition for a three-month extension of time, and a duplicate copy of the previously-filed IDS were filed.³
9. On April 28, 2005, a notice of appeal, reply and third after-final amendment under 37 CFR 1.116 were filed.
10. On June 7, 2005, an advisory action treating the second and third after-final amendments was mailed, indicating that the after-final amendments would not be entered as they raised new issues that would require further consideration and/or search. The advisory action also recognized that the submission of April 8, 2005, was in fact a petition to withdraw the finality of the final Office action mailed October 25, 2004, and forwarded the submission to the appropriate deciding officials.
11. On June 14, 2005, a supplemental petition was filed.⁴

² A duplicate copy of some of these papers was submitted by the petitioners on January 31, 2005.

³ A duplicate copy of some of these papers was submitted by the petitioners on April 18, 2005.

12. On September 9, 2005, a decision signed by a TC Special Program Examiner on the petition filed on April 8, 2005 (that was supplemented on June 14, 2005) was mailed, granting petitioners' request for the consideration of the reference cited in the IDS filed on July 15, 2004, but dismissing the request to withdraw the finality of the Office action of October 25, 2004 and dismissing the request to enter the after-final amendment filed on April 14, 2005.
13. On October 31, 2005, a petition was filed supplementing the petition filed on April 8, 2005 that was further supplemented on June 14, 2005.
14. On November 8, 2005, a decision signed by the TC Director (reissuing the decision mailed on September 9, 2005) was mailed, granting petitioners' request for the consideration of the reference cited in the IDS filed on July 15, 2004, but dismissing the request to withdraw the finality of the Office action of October 25, 2004 and dismissing the request to enter the after-final amendment filed on April 14, 2005.
15. On December 1, 2005, applicants filed a petition for extension of time under 37 CFR 1.136(a) and 1.136(b) and a paper designated as an appeal brief with direction that if prosecution is reopened (*i.e.*, finality of the Office action mailed on October 25, 2004, is withdrawn), it be treated as a reply under 37 CFR 1.111 to the Office action mailed on October 25, 2004. The paper designated as an appeal brief has been treated as an appeal brief because applicants filed a notice of appeal on April 28, 2005, after the claims have been twice rejected.
16. On January 12, 2006, a supplemental petition (to the October 31, 2005 petition) under 37 CFR 1.181 was filed.
17. On February 10, 2006, the Office mailed two petition decisions signed by the TC Director on the same day:
 - (1) A decision on the petitions under 37 CFR 1.181 filed on October 31, 2005 and January 12, 2006, denying the request to withdraw the finality of the final Office action mailed on October 25, 2004 and denying the request to enter the after-final amendment filed on April 14, 2005.⁵
 - (2) A decision on the petition under 37 CFR 1.136(b), dismissing as moot the request for an extension of time.
18. On February 15, 2006, a Notification of Non-Compliant Appeal Brief was mailed, notifying the applicants that the appeal brief filed on December 1, 2005, was defective for failure to comply with one or more provisions of 37 CFR 41.37.

⁴ A duplicate copy of the supplemental petition was submitted by the petitioners on June 17, 2005.

⁵ Contrary to any petitioners' statements that the prosecution is reopened (*see e.g.*, the paper filed on August 1, 2006), the finality of the final Office action mailed on October 25, 2004 is **not** withdrawn. Only the petition under 37 CFR 1.136(b) requesting an extension of time, was dismissed as moot by the TC Director.

19. On April 17, 2006, petitioners filed the instant petition under 37 CFR 1.181 seeking review of the TC Director's decisions mailed on November 8, 2005 and February 10, 2006, requesting the withdrawal of finality of the final Office action mailed on October 25, 2004, and the entry of the after-final amendment filed on April 25, 2005. On the same day, petitioners also filed a petition for an extension of time under 37 CFR 1.136(b) to file an appeal brief.
20. On June 16, 2006, applicants filed a paper entitled "RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF". Applicants did not file any corrected appeal brief, but merely argued that a replacement appeal brief is not required.
21. On August 1, 2006, a paper entitled "REQUEST TO CORRECT PALM AND IFW INFORMATION" was filed.
22. On June 15, 2010, a paper entitled "REVOCATION OF POWER OF ATTORNEY AND POWER OF ATTORNEY WITH STATEMENT UNDER 37 C.F.R. 3.73(b)" was filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.104(c)⁶ provides that:

- (1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.
- (2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.
- (3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

37 CFR 1.113⁷ provides that:

- (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must

⁶ See 37 CFR 1.104(c) (2004).

⁷ See 37 CFR 1.113 (2004).

comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.116⁸ provides that:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

37 CFR 1.136(b)⁹ provides that:

When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings; § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences. Any request under this section must be accompanied by the petition fee set forth in § 1.17(g).

⁸ See 37 CFR 1.116 (2004).

⁹ See 37 CFR 1.136(b) (2004).

37 CFR 1.181(a)¹⁰ provides that (with emphasis added):

(a) Petition may be taken to the Director:

(1) From **any action or requirement of any examiner** in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding **which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;**

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

MPEP § 706.07(a)¹¹ provides in pertinent part that (with emphasis added):

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP § 714.13 II.¹² provides in pertinent part that:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection.

MPEP § 1201¹³ provides in pertinent part that (with emphasis added):

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. **Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.**

¹⁰ See 37 CFR 1.181(2004).

¹¹ See Manual of Patent Examining Procedure (MPEP) § 706.07(a) (8th ed. 2001)(Rev. 2, May 2004).

¹² See MPEP § 714.13 II. (8th ed. 2001)(Rev. 2, May 2004).

¹³ See MPEP § 1201 (8th ed. 2001)(Rev. 2, May 2004).

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

DECISION

Petitioners request that the finality of the final Office action mailed on October 25, 2004 (hereafter “the final Office action”) be withdrawn and that the after-final amendment filed on April 28, 2005 be entered. Petitioners’ request was previously reviewed and decided by the TC Director. See the dismissal decision mailed on November 8, 2005 and the denial decision mailed on February 10, 2006. The issues being decided in the instant decision are: (1) whether the finality of the final Office action mailed on October 25, 2004 should be withdrawn; and (2) whether the after-final amendment filed on April 28, 2005 should be entered.¹⁴

A review of the record of the instant application shows that a non-final Office action was mailed on February 11, 2004 (hereafter “the non-final Office action”) after the filing of an RCE. The examiner stated in the non-final Office action that 133 claims were pending in the application, 124 claims were rejected, and 9 claims would be allowed if they were rewritten in independent form. The non-final Office action set forth, *inter alia*, the following three prior art rejections with explanations:

- (1) 46 claims were rejected under 35 U.S.C. § 102(e) as being anticipated by Goetz et al., U.S. Patent 5,854,913;
- (2) 2 claims were rejected under 35 U.S.C. § 102(b) as being anticipated by Brender et al., U.S. Patent 5,339,422, which incorporated by reference Murphy et al., U.S. Patent 5,764,947; and
- (3) 76 claims were rejected under 35 U.S.C. § 103 as being unpatentable over Goetz in view of Brender and Murphy.

Essentially, the examiner rejected 124 claims using only three prior art references (Goetz, Brender and Murphy) in the non-final Office action.

In response to applicants’ reply, a final Office action was mailed on October 25, 2004, in which the examiner stated 129 claims were pending, 69 claims were rejected, and 60 claims would be

¹⁴ The relevant facts related to these two issues are set forth in the instant decision. Most of the petitioners’ statements including those that are labeled as “facts” and/or “undisputed facts” in the instant petition are not actually “facts” or “undisputed facts” but are simply petitioners’ contentions and allegations. The absence of a discussion of a contention or allegation by petitioners should not be taken as agreement with petitioners as to the contention or allegation.

allowed. The final Office action set forth the same three rejections based on the same three prior art references:

- (1) 17 claims were rejected under 35 U.S.C. § 102(e) as being anticipated by Goetz et al., U.S. Patent 5,854,913;
- (2) 2 claims were rejected under 35 U.S.C. § 102(b) as being anticipated by Brender et al., U.S. Patent 5,339,422, which incorporated by reference Murphy et al., U.S. Patent 5,764,947; and
- (3) 50 claims were rejected under 35 U.S.C. § 103 as being unpatentable over Goetz in view of Brender and Murphy.

The examiner incorporated by reference the explanations of the rejections in the non-final Office action, and also provided responses to applicants' arguments in paragraph 14 on pages 2-5 of the final Office action.

In determining whether a second or subsequent Office action may be made final, if the statutory basis for the rejection remains the same, and the reference(s) relied upon in support of the rejection remains the same, the rejection is not considered a new ground of rejection in the final Office action unless the examiner's reasoning in support of the rejection in the latter Office action changes the basic thrust of the rejection relative to the rejection as set forth in the previous Office action. In the instant application, the examiner maintained the same statutory basis of rejection and relied upon the same references. The final Office action merely elaborated on the rejections in response to applicants' arguments, and thus it did not change the basis thrust of the rejections. Accordingly, the final Office action did not introduce any new grounds of rejection within the meaning of MPEP § 706.07(a). The finality of the final Office action is **not** withdrawn.

Petitioners' arguments related to the issues of the finality of the final Office action and the entry of the after-final amendment will be addressed in detail below.

I. The Finality of the Final Office Action Mailed on October 25, 2004

Petitioners allege that "MPEP 706.07(a) imposes two separate requirements before prosecution may be closed: (a) all requirements of 'present practice' must have been timely completed, and (b) no new ground of rejection may be raised, unless necessitated by amendment."

Contrary to petitioners' contention, MPEP § 706.07(a)¹⁵ provides, in pertinent part, that:

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on

¹⁵ See MPEP § 706.07(a) (8th ed. 2001)(Rev. 2, May 2004).

information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (Emphasis added.)

The phrase “under present practice” used in the second paragraph merely distinguishes the practice currently set forth in MPEP § 706.07(a) from the former practice discussed in the first paragraph. Therefore, petitioners are misconstruing the phrase “under present practice” to demand every statement made in an Office action to be in strict compliance of what they deemed “procedural” requirements of the rules and MPEP.

Even though the examiner did not change the statutory basis of the rejections and did not rely upon any new reference, petitioners contend that the final Office action contains a new ground of rejection that is not necessitated by any amendment of the claims. Specifically, petitioners allege that new issues were raised with respect to one of the limitations (“control transfer instruction”) in claim 87 when an “entirely different portion” of a reference was relied upon. Petitioners also argue that the final Office action was prematurely made final in view of the typographic error in the examiner’s response to applicants’ arguments regarding claim 104, and the examiner’s response to applicants’ argument raised new issues in the advisory action that constituted a new ground of rejection. Additionally, petitioners contend that the final Office action was prematurely made final because the examiner shifted from a single reference for one of the limitations (“the data storage convention”) in claim 22 to a combination of three references.

Responses to petitioners’ arguments related to claim 87

Contrary to petitioners’ allegation, the examiner did not rely upon a different portion of the reference in the rejection for claim 87. In the non-final Office action, claim 87 (along with 75 other claims) was rejected under 35 U.S.C. § 103 as being unpatentable over Goetz in view of Brender and Murphy (see paragraphs 46 through 100 of the non-final Office action). Since the claims are directed to the same patentable invention and contain the same or similar claim limitations, the examiner provided detailed explanations for the rejection of all 76 claims together in paragraphs 46 through 100. A review of the record shows that the examiner practically relied upon the entire written disclosure of each reference for rejecting all 76 claims.

The **same** rejection on claim 87 (along with 49 other claims) was maintained and incorporated by reference in the final Office action (see paragraphs 11 and 12 of the final Office action). The examiner did not change the statutory basis of the rejection and did not rely upon any new reference. The examiner provided responses to applicants’ arguments in paragraph 14 on pages 2-5 of the final Office action. Specifically, in subparagraph 14.4, the examiner merely provided further explanation to elaborate on the rejection in response to applicants’ argument regarding the “control transfer instruction” limitation of claim 87. Therefore, the examiner did not make a new ground of rejection within the meaning of MPEP § 706.07(a) with respect to claim 87.

Even if a different portion of the reference was relied upon, referencing additional portions of the same reference to elaborate on the rejection does not constitute a new ground of rejection. *See In re DCB*, 545 F.3d 1373, 1382, n5 (Fed. Cir. 2009)(The Board’s decision does not constitute a

new ground of rejection when the Board cited the English translation of the Japanese patent, while the examiner relied upon only the abstract of the Japanese patent.); *In re Hedges*, 783 F.2d 1038, 1039-40 (Fed. Cir. 1986) (Relying upon new portions of the references for further support of a rejection under 35 U.S.C. § 103 is not a new ground of rejection); *In re Meinhardt*, 392 F.2d 273, 280 (CCPA 1968)(Even if the Board relied upon a portion of the disclosure ignored by the examiner, this could not constitute a new ground of rejection because it is proper for the court and necessarily, the board, to consider everything that a reference discloses.).

Responses to petitioners' arguments related to claim 104

Contrary to petitioners' allegation regarding claim 104, the final Office action was not incomplete merely because there was a typographic error in the response to applicants' argument regarding one of the limitations in claim 104. In the non-final Office action, claim 104 (along with 45 other claims) was rejected under 35 U.S.C. § 102(e) as being anticipated by Goetz (see paragraphs 10 through 42 of the non-final Office action). Since the claims are directed to the same patentable invention and contain the same or similar claim limitations, the examiner provided detailed explanations for the rejection of all 46 claims together in paragraphs 10 through 42. Particularly, since claim 104 is a redraft of claim 4, containing mostly the same limitations, the examiner provided detailed explanations that address the limitations in claim 4 in paragraph 12 and referred back to that paragraph for the explanation of claim 104. A review of the record shows that the examiner practically relied upon the entire written disclosure of the reference for rejecting all 46 claims.

The **same** rejection on claim 104 was maintained and incorporated by reference in the final Office action (see paragraphs 10 and 12 of the final Office action). In the final Office action, the examiner applied the same statutory basis and same prior art reference (Goetz) as in the non-final Office action. The examiner did not change the statutory basis of the rejection and did not rely upon any new reference. In response to applicants' arguments, the examiner provided further explanations in paragraph 14 on pages 2-5 of the final Office action. Even though the examiner made a typographic error in the response regarding the "first and second data storage conventions" limitation of claim 104, it should be clear to the applicants that this limitation was clearly addressed by the examiner in paragraph 12 of the non-final Office action (which was incorporated by reference in the final Office action). Therefore, the typographic error in the response to applicants' argument on this limitation of claim 104 is minor and does not affect the examiner's rejection or render the final Office action incomplete.

Contrary to petitioners' contention that the advisory action mailed on February 14, 2005 raised new issues, the examiner merely provided further explanation to elaborate on the rejection in his response to applicants' argument regarding claim 104. As previously stated, even if a different portion of the reference was relied upon, referencing an additional portion of the same reference to elaborate on the rejection does not constitute a new ground of rejection. See *In re DCB*, 545 F.3d at 1382, n5; *In re Hedges*, 783 F.2d at 1039-40; *In re Meinhardt*, 392 F.2d at 280. Therefore, the examiner did not make a new ground of rejection within the meaning of MPEP § 706.07(a) with respect to claim 104.

Contrary to petitioners' allegation that the examiner expressly admits that the Office actions are confusing, the examiner merely states that the applicants are "in error" and "additionally confused." A review of the record of the instant application shows that the examiner has responded to each traversal in a timely manner and addressed all points raised by applicants, by providing further explanations in response to applicants' arguments. However, petitioners misconstrued the examiner's explanations as evidence for incompleteness of the Office actions and as a basis for alleging a new ground of rejection.

Responses to petitioners' arguments related to claim 22

Contrary to petitioners' contention regarding claim 22, the rejection for claim 22 did not shift from a single reference to a combination of three references. In the non-final Office action, claim 22 (along with 75 other claims) was rejected under 35 U.S.C. § 103 as being unpatentable over Goetz in view of Brender and Murphy (see paragraphs 46 through 100 of the non-final Office action). The examiner provided detailed explanations on claim 22 in paragraphs 52-53. Petitioners' arguments focus only on subparagraph 52.4 of the non-final Office action where the examiner discussed only the teachings of the primary reference (Goetz). However, petitioners failed to read paragraphs 52 and 53 in their entirety, in which the examiner's explanation continued to discuss the teachings (*e.g.*, "the data storage convention") of the secondary references, Brender and Murphy, and the combination of the three references (see paragraphs 52-53 of the non-final Office action). Accordingly, claim 22 was clearly rejected based on a combination of the three prior art references in the non-final Office action, contrary to petitioners' allegation that it was based on a single reference. The same rejection for claim 22 was maintained and incorporated by reference in the final Office action (see paragraphs 11-12 of the final Office action). Therefore, the examiner did not make a new ground of rejection within the meaning of MPEP § 706.07(a) with respect to claim 22.

Contrary to petitioners' allegation that the examiner failed to address applicants' traversal as required by MPEP § 706.07, in response to applicants' arguments regarding claim 22 (which were presented in the reply to the non-final Office action and the after-final reply filed on January 25, 2005), a review of the record of the instant application shows that the examiner has responded to each traversal in a timely manner and addressed all points raised by applicants. Particularly, the examiner provided further explanations in response to applicants' arguments in paragraph 14 on pages 2-5 of final Office action, and page 2 of the advisory action mailed on February 14, 2005. As a matter of fact, petitioners argue (on page 22 of the instant petition) that the examiner's explanations provided in response to the applicants' arguments regarding claim 22 constituted a shift from a single reference to a combination of three references (this argument was addressed in the previous paragraph of this decision). Petitioners even reproduced the examiner's explanations regarding the claim limitation on page 22 item 26 of the instant petition. If petitioners are contesting the sufficiency of the examiner's rebuttal, the issue of whether the examiner sufficiently rebuts the applicants' argument that the references relied upon do not show a claim limitation is an issue on the merits of the rejection which is an appealable matter rather than a petitionable matter.

Contrary to petitioners' allegation that the status of claim 22 is too unclear to permit appeal or closure of prosecution, the examiner clearly set forth that claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of Brender and Murphy, in paragraphs 46 and 52-53 of the non-final Office action and in paragraphs 11-12 of the final Office action. Accordingly, a complete statement of the ground of rejection for claim 22 has been provided in both Office actions, and the examiner's position that claim 22 is rejected under 35 U.S.C. § 103(a) over a combination of the three references is clear.

Contrary to petitioner's contention that the TC Director decision mailed on November 8, 2005 did not address the issues related to claim 22, the TC Director specifically stated in his decision (pages 4-5) the following (with emphasis added):

With respect to the petition at hand, in the instant application, with respect to claims 22, 87 and 104, a comparison of the Non-Final Office action of February 11, 2004 with the Final Office action of October 25, 2004 reveals that the Examiner maintained the same statutory basis of rejection for each of claims 22, 87 and 104. That is, claim 104 was rejected in both actions under 35 USC 102(e) as being clearly anticipated by Goetz et. Al. (US 5,854,913) and claims 22 and 87 were each rejected in both actions under 35 USC 103(a) as being obvious over Goetz et al. (US 5,854,913) in view of Brender et al. (US 5,339,422) and Murphy et al. (US 5,764,947).

First, Petitioner should be advised that there is no requirement that an element for element or limitation for limitation identification (between the claims and reference(s) be provided to applicant in the grounds of rejection set forth in the examination process, particularly in a rejection wherein the identification of the claimed limitations are readily apparent. Second, upon careful reading of both the Non-Final Office action of February 11, 2004 and the Final Office action of October 25, 2004, it is apparent that the Examiner has fully developed a position on the above identified claims in these Office actions. Further, the position taken by the Examiner has been presented to Applicant in multiple Office communications including the Final rejection. Specifically, with respect to each of claims 104, 22, 87, the Examiner's rejection of these claims is identified clearly in the Non-Final Office action at paragraphs 10 and 46, respectively. In applicant's response filed July 15, 2004, in which these claims were not amended but separately argued that the applied references do not teach a feature of the claim(s), the Examiner responded directly (in the Final rejection of October 25, 2005) to Applicant's arguments by pointing out where the argued feature was taught.

Responses to petitioners' arguments related to the issue of whether every claim limitation is required to be particularly pointed out

Petitioners argue that the Office actions failed to particularly point out where every claim limitation is met by the references as required by 37 CFR 1.104(c)(2) and 1.113(b) and MPEP §§ 706.07 and 707.07(f). Specifically, petitioners allege that the references relied upon in the rejections applied to claims 22, 87 and 104 are complex and/or "show or describe inventions other than that claimed by the applicant." However, petitioners did not provide any showing to support this contention, nor any explanation as to why the references are complex to the petitioners other than stating that the references contain a total of 70 columns.

A review of the record in the instant application shows that the applicants presented, on filing, 143 pages of written description, 20 pages of claims, and 41 sheets of drawings, and applicants filed a total of 239 references in several IDSs. The examiner considered all 239 references cited by the applicants, examined 133 pending claims, and relied upon only **three** references to reject 124 claims in the non-final Office action. The non-final Office action contains 23 pages of statements of rejection and written explanations. Most of the claim limitations were pointed out by the examiner, especially those that may not have been readily apparent. Out of the 124 rejected claims, petitioners allege only **three** claim limitations that were not particularly pointed out (one limitation in each of claims 22, 87 and 104). Goetz was used in all three rejections as the sole reference or the primary reference in combination with two other references. Brender (which incorporated by reference Murphy) and Murphy were used in two rejections as secondary references. These three references disclose the same subject matter as the applicants' invention (computer architecture).

Based on the facts of the instant application, the three references relied upon should not be complex to the applicants, or applicants' representative, who presented 133 pending claims, 143 pages of written description, and 239 references for the examiner to consider. Accordingly, the non-final Office action and the final Office action were **not** required to particularly point out where every claim limitation is met by the references. *See* 37 CFR 1.104(c)(2)(**When a reference is complex or shows or describes inventions other than that claimed by the applicant**, the particular part relied on must be designated as nearly as practicable)(emphasis added).

Responses to petitioners' arguments related to the reasoning underlying the obviousness rejections

Petitioners contend that the requirements set forth in MPEP §§ 2141-2143.03 must be satisfied before prosecution may be closed pursuant to MPEP § 706.07(a). Particularly, petitioners allege that the Office actions were incomplete because they did not set forth the *prima facie* elements required by MPEP §§ 2141-2143.03 with respect to the "control transfer instruction" claim limitation in claim 87 and the "indicator elements" claim limitation in claim 22. MPEP §§ 2141-2143.03 set forth the examination guidelines for determining obviousness under 35 U.S.C. § 103, including the basic factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and exemplary rationales to support rejections under 35 U.S.C. § 103. Thus, petitioners are alleging that the prosecution may not be closed pursuant to MPEP § 706.07(a) if the examiner's rationale and reasoning underlying the obviousness rejections for claims 87 and 22 are insufficient. In essence, petitioners are requesting the Director to review, on petition, the merits of the examiner's rejection and the reasoning underlying the rejection set forth in the non-final Office action. Even though petitioners creatively draft their challenge as a petitionable matter (withdraw the finality of an Office action) under 37 CFR 1.181, petitioners are actually seeking review of the reasoning underlying the examiner's rejection. Petitioners' artful pleading will not be permitted to convert subject matter that is subject to appeal to the Board (and further tribunal review) into subject matter that is reviewable on petition.

37 CFR 1.181 makes clear that matters subject to appeal to the Board are not petitionable. Issues related to the merits of a patentability rejection are appealable to the Board rather than petitionable to the Director. See 35 U.S.C. § 134 and MPEP §§ 706.01 and 1201. The Board has jurisdiction over the examiners' rejections and rationale in support of these rejections, and the examiners are bound by the decisions of the Board. See *In re Loehr*, 500 F.2d 1390 (CCPA 1974). The issue of whether a rejection made by the examiner sets forth a *prima facie* case of obviousness and the issue of whether the examiner sets forth sufficient reasoning to support an obviousness rejection are directed to the merits of the examiner's rejection, which have been held to be appealable matters rather than petitionable matters. See e.g., *Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1471 (E.D. Va. June 2004); *Stagner v. U.S. Patent and Trademark Office*, 8 USPQ2d 1173, 1174 (D. Kan 1988) (court lacked jurisdiction since "applicant must first present his claims to the Board of Patent Appeals prior to resort to the courts"), *further opinion*, 11 USPQ2d 1553, 1556 (D. Kan. 1989), *aff'd*, 14 USPQ2d 1671 (Fed. Cir. 1990). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board. See *In re Dickinson*, 299 F.2d 954, 958 (CCPA 1962); *Bayley's Restaurant v. Bailey's of Boston, Inc.*, 170 USPQ 43, 44 (Comm'r Pat. 1971); *In re Oku*, 25 USPQ2d 1155, 1157 (Comm'r Pat. 1992). Furthermore, if such a review is permitted pursuant to a petition under 37 CFR 1.181 for withdrawal of the finality of an Office action, petitioners would be permitted to seek review of a non-final Office action from the Director and courts as a petitionable matter, which would be contrary to the legal precedents. See *Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d at 1471 (Individual examiners' actions are not final actions subject to review as a final agency action under Administrative Procedure Act, 5 U.S.C. 701-06.)

Accordingly, the issues of (1) whether a rejection made by the examiner sets forth a *prima facie* case of obviousness, (2) whether the examiner sets forth sufficient reasoning to support an obviousness rejection, and (3) whether the examiner sufficiently rebutted applicants' arguments presented in the replies to an Office action, are directed to the merits of the examiner's rejection, which are appealable matters to the Board, and they are not reviewable on petition. If petitioners wish to seek review of these issues, petitioners may timely file an appeal brief under 37 CFR 41.37 since petitioners have already filed a notice of appeal in the instant application.

Contrary to petitioners' assertion that the TC Director did not address this issue in his decision, the TC Director's decision on the petition under 37 CFR 1.181 mailed February 10, 2006 (on page 5) stated that "a question of whether the examiner's rejection is clear as to claim scope or what is the proper scope of a claim is directed to the sufficiency of the examiner's *prima facie* case and is therefore a matter for review on appeal and not subject to review by petition."

Response to petitioners' arguments related to the definition of "a new ground of rejection"

Petitioners contend that the phrase "new ground of rejection" has the following meaning: "any 'position or rationale new to the proceedings' (new evidence, citation to an entirely different portion of existing evidence, a new inference drawn from an existing reference, a new legal

theory, a new application of law to facts).” Petitioners also allege that designating a new “particular part relied on” or a “different portion” of a reference is a new ground of rejection.

Contrary to the petitioners’ contention that any new position or rationale is a new ground of rejection, there are situations where a new position or rationale does not constitute a new ground of rejection. Particularly, changing a § 103 rejection based on reference A in view of reference B to a § 103 rejection based on reference B in view of reference A (which involves changing the rationale for combining the references) does not constitute a new ground of rejection. *See e.g., In re Cowles*, 156 F.2d 551 (CCPA 1946) and *In re Cook*, 372 F.2d 563 (CCPA 1966), *In re Bush*, 296 F.2d 491 (CCPA 1961). Changing a § 103 rejection to a § 102 rejection based on the same reference is not a new ground of rejection. *See In re May*, 574 F.2d 1082 (CCPA 1978). Also, the usage of a new dictionary definition to “fill in the gaps” in the evidentiary showing made by the examiner to support a rejection is not a new ground of rejection. *See In re Boon*, 439 F.2d 724, 727-728 (CCPA 1971), *citing In re Ahlert*, 424 F.2d 1088, 1092 (CCPA 1970)(It is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching.). Furthermore, the new calculations presented by the Office to rebut the appellants’ argument of non-obviousness do not necessarily constitute a new ground of rejection when the statutory basis for the rejection remained the same. *See In re Plockinger*, 481 F.2d 1327, 1331-32 (CCPA 1973).

As previously stated, referencing an additional portion of the same reference to elaborate on the rejection does not constitute a new ground of rejection. *See In re DCB*, 545 F.3d at 1382, n5 (The Board’s decision did not constitute a new ground of rejection when the Board relied upon an example in the English translation of the Japanese patent, while the examiner relied upon only the abstract of the Japanese patent.); *In re Hedges*, 783 F.2d at 1039-40 (Relying on new portions of the references for further support of a § 103 rejection is not a new ground of rejection); *In re Meinhardt*, 392 F.2d at 280 (Even if the Board relied upon a portion of the disclosure ignored by the examiner, this could not constitute a new ground of rejection because it is proper for the court and necessarily, the board, to consider everything that a reference discloses.).

To support their contentions, petitioners cited the following cases: *In re DeBlauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984); *In re Eynde*, 480 F.2d 1360 1370-71 (CCPA 1973); *In re Echerd*, 471 F.2d 632, 635 (CCPA 1973); and *In re Wiechert*, 370 F.2d 927, 933 (CCPA 1967).

However, a thorough review of these cases shows that petitioners mischaracterized some of the cases and overly generalized the holdings. For example, petitioners state that *In re Echerd* was reaffirmed by *In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976), and imply that *In re Eynde* was cited by *In re Kronig* with approval. A review of the *Kronig* opinion shows that these cases were merely listed as cases cited by appellants to support their position that the Board made a new rejection, but the court in *Kronig* did not find these cases controlling in view of the facts. Rather, the court in *Kronig* held that there is no new ground of rejection when the basic thrust of the rejection remains the same such that an applicant has been given a fair opportunity to react to the rejection. *See Kronig*, 539 F.2d at 1302-03. Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily

constitute a new ground of rejection. *Id.* Furthermore, the cases cited by the petitioners to support their contentions do not apply to the instant application in view of the facts because the examiner merely elaborated on the rejection in response to applicants' arguments. The facts in *DeBlauwe* involve a challenge of the applicant's assertions and objective evidence of unexpected results for the first time in the Solicitor's brief during an appeal to the Federal Circuit. In the instant application, applicants did not offer any objective evidence of unexpected results. The facts in *Eynde* involve a Board decision in which the Board relied upon a new reference in its conclusion. The rationale of this case does not apply here. In the instant application, the examiner did not rely upon any new references in his rejections. In *Echerd*, the Board changed the statutory basis of the rejection from § 103 to § 102, and made new assumptions of inherent characteristics in a different portion of the reference. Petitioners misquoted the case by eliminating the basic rationale of the court's holding, and overly generalized the case when they cited the case to support the petitioners' allegation that citing a different portion of a reference is a new ground of rejection. This case does not apply to the instant application because the examiner did not change the statutory basis from § 103 to § 102, and did not make any new assumptions of inherent characteristics or any other new theory. In *Wiechert*, the Board's decision was based on a completely different compound than the compound relied upon by the examiner. Petitioners overly generalize the case when they cited it to support the petitioners' contention that every designation of a new portion of a reference is a new ground of rejection, and they misquote the case by eliminating the basic rationale of the court's holding. This case does not apply to the instant application because the examiner did not rely upon a completely different compound or embodiment, but merely elaborated on the rejection in response to applicants' argument.

The petitioners also cited *In re Kumar*, 418 F.3d 1361, 1367 (Fed. Cir. 2005) for their contention that an additional explanation in response to applicant's showing is a new ground of rejection. Petitioners overly generalize the case and misquote the case by eliminating the basic rationale of the court's holding. In *Kumar*, instead of basing its decision on the values directly disclosed by the reference, the Board "went off on its own" and made new calculations based on new assumptions. See *Kumar*, 418 F.3d at 1367. The Board in *Kumar* did not merely provide an additional explanation. Furthermore, this case does not apply to the instant application because the examiner did not make any new calculations based on any new assumptions in the final Office action.

In determining whether a second or subsequent Office action may be made final, if the statutory basis for the rejection remains the same, and the reference(s) relied upon in support of the rejection remains the same, the rejection is not considered a new ground of rejection in the final Office action unless the examiner's reasoning in support of the rejection in the latter Office action changes the basic thrust of the rejection relative to the rejection as set forth in the previous Office action. At the final Office action stage, applicants still have opportunities to respond to new positions or rationales in support of the rejection and as stated previously, a final Office action is not the agency's final position. In the instant application, the examiner maintained the same statutory basis of rejection and relied upon the same reference(s) for each of claims 22, 87 and 104. The final rejection merely elaborated on the rejections in response to applicants' arguments, and thus it did not change the basis thrust of the rejection and applicants were given a

fair opportunity to react to the rejections. Accordingly, the final Office action did not introduce any new grounds of rejection within the meaning of MPEP § 706.07(a).

II. Entry of the Third After-Final Amendment Filed on April 28, 2005

For the above stated reasons, the finality of the final Office action mailed on October 25, 2004 is **not** withdrawn. Applicants filed a notice of appeal, reply and third after-final amendment on April 28, 2005, with a statement that this amendment replaces the after-final amendment filed April 14, 2005. Petitioners request the entry of the third after-final amendment filed on April 28, 2005, which proposes to amend claims 63, 87, 92 and 104, add claims 134-141 and cancel 117-118.

37 CFR 1.116(b)(3) provides that “[a]n amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons **why the amendment is necessary** and was not earlier presented.” (Emphasis added.)

MPEP § 714.13 II.¹⁶ provides in pertinent part that:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection.

Petitioners allege that these amendments to the claims could not have been presented earlier because the examiner had not earlier indicated the portions of the references on which he now relies, or provided a clear explanation of his position. Petitioners’ showing of good and sufficient reasons under 37 CFR 1.116(b)(3) merely repeats their earlier allegations that the Office actions were incomplete, specifically that three claim limitations out of 124 rejected claims were not particularly pointed out in the non-final Office action.

However, petitioners failed to provide any explanation as to why the after-final amendment is necessary, and how the proposed amendments to the claims (*e.g.*, the new claims 134-141 and the added language to claim 63) related to the three claim limitations that they alleged were not particularly pointed out in the Office actions. As previously stated, based on the facts of the instant application, the Office actions were not required to particularly point out where every claim limitation is met by the references. Furthermore, a review of the record of the instant application shows that the examiner has provided a complete statement of the ground of rejection for the rejected claims and responded to each traversal in a timely manner, addressing all points raised by the applicants.

¹⁶ See MPEP § 714.13 II. (8th ed. 2001)(Rev. 2, May 2004).

Contrary to petitioners' allegation that the examiner and the TC Director did not decide on this issue under 37 CFR 1.116(b)(3), the examiner and the TC Director specifically addressed the applicants' arguments related to the completeness of the Office actions. For example, the TC Director decision of November 8, 2005 (on page 5) provided: "Petitioner should be advised that there is no requirement that an element for element or limitation for limitation identification (between the claims and references(s)) be provided to applicant in the grounds of rejection...the Examiner responded directly (in the Final rejection of October 25, 2005) to Applicant's arguments by pointing out where the argued feature was taught." Also, the examiner provided an advisory action on June 7, 2005, stating that the new language added to claim 63 would require further search and consideration, and the TC Director's decision of November 8, 2005 (on page 6) clearly stated the following:

Newly amended claim 63, as proposed, is not equivalent to a previously presented claim, but rather it presents a combination of limitations not previously presented. This change in scope of the claim limitations requires more than a cursory review, as indicated in the Advisory Action mailed June 7, 2005. In addition, it is noted that the proposed amendment of April 25, 2005 presents additional claims (proposed claims 134 [through 141]) without canceling a corresponding number of finally rejected claims.

For the above stated reasons, the entry of the third after-final amendment filed on April 28, 2005, is **denied**.

Since the examiner indicated in the final Office action that 54 claims are allowable and 12 claims would be allowable if rewritten in independent form, applicants may file an amendment under 37 CFR 41.33, that does not raise any new issues, to place the application in condition for allowance (e.g., cancel the rejected claims and rewrite the objected claims in independent form). Applicants may also file an RCE under 37 CFR 1.114 to seek the consideration of the after-final amendment.

CONCLUSION

For the above stated reasons, the petition under 37 CFR 1.181, requesting the withdrawal of the finality of the final Office action mailed on October 25, 2004, and the entry of the after-final amendment filed on April 28, 2005, is **DENIED**. This decision may be viewed as a final agency action upon entry of a final decision by the Board. *See* MPEP § 1002.02(b).

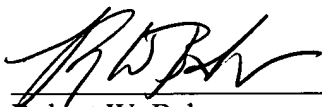
Accordingly, the finality of the final Office action mailed on October 25, 2004 is **not** withdrawn and the entry of the after-final amendment filed on April 25, 2005 is denied.

The petition under 37 CFR 1.136(b), requesting extensions of time for filing an appeal brief, is **GRANTED** to the extent that a one-month time period is provided to the applicants to file an appeal brief in compliance with 37 CFR 41.37.

The response to the notice of non-compliant appeal brief filed on June 16, 2006 is not responsive because it did not include a corrected appeal brief as required by the Notification of Non-

Compliant Appeal Brief mailed on February 15, 2006. Accordingly, an appeal brief in compliance with 37 CFR 41.37 must be filed within the **one month** from the mailing date of this decision to avoid *sua sponte* dismissal of the appeal. This time period is extendable under 37 CFR 1.136(a). Applicants may also file an RCE in compliance with 37 CFR 1.114 during the pendency of the instant application.

In addition, the request to correct PALM and IFW information filed on August 1, 2006, requesting that the status of the instant application be changed to a status indicating the response to non-final Office action is entered, is dismissed. At the time of the mailing of this decision, the status of the instant application will be changed to the status on appeal waiting for applicants to file an appeal brief.



Robert W. Bahr

Acting Associate Commissioner for
Patent Examination Policy